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09/986,026	11/07/2001	Hiroyuki Kishi	1506.1013	4741

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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

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BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Application Number: 09/986,026
Filing Date: November 07, 2001
Appellant(s): KISHI, HIROYUKI

KISHI, HIROYUKI
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 9/8/08 appealing from the Office action mailed 2/26/08.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings that will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

The following is a listing of the evidence (e.g., patents, publications, Official Notice, and admitted prior art) relied upon in the rejection of claims under appeal.

Quinlin, US Patent 6,748,365, June 8, 2004

Solomon et al., US Patent 6,847,935, Jan 25, 2005

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(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims. This is a verbatim copy of the final rejection mailed on 2/26/08.

DETAILED ACTION

This action is in response to the Communication response filed on 12/6/2007.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

> Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1-4, 6, 11-12 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

In order for a method to be considered a "process" under §101, a claimed process must either: (1) be tied to another statutory class (such as a particular apparatus) or (2) transform underlying subject matter (such as an article or materials). Diamond v. Diehr, 450 U.S. 175, 184 (1981); Parker v. Flook, 437 U.S. 584, 588 n.9 (1978); Gottschalk v. Benson, 409 U.S. 63, 70 (1972). If neither of these requirements is met by the claim, the method is not a patent eligible process under §101 and is non-statutory subject matter.

Examiner finds these method claims lack structure such as on a “computer readable medium”. One example of corrective action might be to place “electronically" before an action verb and “on computer (or other appropriate structure)."

For example in the claim:

“Method comprising:

Calculating a score

Assigning rank…"

Would need to become:

"Method comprising:

Electronically calculating a score on a processor…

Electronically assigning rank on a processor…"

This is just one elementary example to provide guidance however there many be various ways to overcome the 101 method without structure rejection.

Claim Rejections - 35 USC § 103

The Examiner has read and reviewed all of the information provided by the Applicant. The examiner rejects as final claims 1-4, 6-9, 11-12, 16-17, 20-21 under 35 USC 103.

The Applicant attention is re-drawn to the following:

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 1-4, 6-9, 11-12, 16, 17, 20 and 21 rejected under 35 U.S.C. 103(a) as being unpatentable over Quinlin et al in view of Solomon et al.

Quinlan et al. teaches and method and system for redeeming rebates. Specifically, Quinlan et al. teaches a fulfillment administrator that receives an electronic file transfer from a point-of-sale data processing and storage system comprise a plurality of purchase data records. Each purchase data record comprises a list of

products purchased, the date and the transaction serial number for the qualified transaction. The purchase record may also comprise other data such as store number. (column 9; lines 39-42 & 47-52).

Examiner notes that this represents receiving first sales information generated by a retail seller, which identifies a deal of a first commodity, retail seller and a time and place. It also teaches storing the received information in a first storing part.

Quinlan et al. further teaches a consumer makes a rebate claim by entering and transmitting a serial number corresponding to the qualified transactions and identifying information such as personal information about the consumer (column 9; lines 18-22). Quinlan et al. teaches that serial number corresponding to the qualified transaction is provided to the user at the time of purchase on a receipt by the point-of-sale (reference column 8; lines 18-61). Examiner notes that the serial number corresponding to the qualified transaction represents Applicant's second sales information, as it is generated by the retail seller and identifies the retail seller, time and place at which commodity was sold. As such Examiner notes that this teaching represents receiving purchase information, which comprises personal information and second sales information generated by the retail seller identifying the retail seller, place and time at which second commodity was sold.

Examiner further notes that as Applicant's invention is intended to match purchase information, then in the case where the purchase information matches, the first commodity and the second commodity are one and the same. In addition, as the fulfillment administrator collects information on a plurality of products from both the

point-of-sale and the consumer, it is consistent that the information collected will be on first and second commodities.

Quinlan et al. teaches the fulfillment administrator then associates each serial number in the stored data record with a purchase data record having an identical serial number. Thus for each serial number transmitted by a customer and stored as a stored data record, there is a corresponding purchase data record with the identical serial number received by the electronic file transfer (column 10; lines 6-15). Examiner notes that the purchase data record represents Applicant's first storing part and stored data record represents Applicant's second storing part. Examiner further notes that corresponding the stored data record with the purchase data record represents storing the information as a valid purchase information.

Examiner notes that the stored data record of Quinlan et al., discussed above includes information for identifying the seller, identifying a deal made by the seller and identifying the second commodity (claim 2). Examiner once again notes that the serial number of Quinlan et al. is used to identify all of these things.

Examiner notes that the stored data record indicates both a time order of deals and a date of the deal (claims 3 and 4). Examiner notes that the date of the transaction is both the date and an indication of the time order of the deal.

Quinlin et al. teaches transmitting a display screen with an input area for inputting purchase information (claim 6). Reference column 12; lines 1-7.

Quinlin et al. does not teach storing the second information as one of valid purchase information, invalid purchase information or unidentified validity purchase information based on a verification process that includes determining whether purchaser submitted purchasing data in saved in the first storage part including a range of values of a second information between a minimum value of the second information to a maximum value of the second information.

Solomon et al. teaches as part of a rebate processing system determining breakage, which refers to any event that prevents a rebate from being completed, for example denying based on improper purchase dates or purchase price (this represents the second information being within a range from a minimum to a maximum, i.e. min date to max date or min price to max price). In order to track breakage a submitted rebate request from a user must be stored with an indication of the rebate status (e.g. valid, invalid or unidentified validity) . (see column 5, lines 24-49 and column 6, lines 38-45).

It would have been obvious to one of ordinarily skill in the art at the time of the invention to modify the rebate processing system of Quinlin to include storing with the user submit request a rebate status indication whether the request is valid, invalid or unidentified validity as taught by Solomon. One of ordinary skill in the art would have been motivated to modify the references in order to track breakage rate.

Examiner notes that claims 1-4 and 6, rejected above are directed to a purchase information collection method. Claims 7-9, directed to a purchase information colleting program, are rejected as an apparatus for performing the method of 1-4 and 6. Claims

11-12 are directed toward a purchase information collecting method and are rejected with claims 1-4 and 5. Claim 16 is directed towards a purchase information collecting program. Examiner notes that claims 16 and 17 are rejected as an apparatus for performing the method of claims 1-4 and 6 (detailed above). Finally claim 20 is directed towards a method performed by a computing system. Examiner reference the rejection to claims 1-4 and 6 in rejection of claims 20 & 21.

Quinlan alone does not teach: “range of deal numbers of second information between a minimum deal number of the second information to a maximum deal number of second information” and “range of deal numbers... minimum deal number and maximum deal number"

However, combined with Solomon “date range” and “price range” and Quinlan serial number as a unique identifier this combination is identical to the applicants "deal number range"

One would be motivated to combine these references to simplify the process.

Response to Arguments

Applicant's arguments filed 10/10/2006 have been fully considered but they are not persuasive.

In particular, and respect to Claim 1 the Applicant argued 1st: prior art does not specify: “range of deal numbers of second information between a minimum deal number of second information to a maximum deal number of second information."

The Examiner refutes the argument made by the Applicant and draws the attention to Solomon Quinlan combination. As described before Quinlan has the unique

identifier of the serial number combined with the range (date and price) of Solomon it operates identical to the applicants "deal number"

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action.

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Contact Information

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kirsten S. Apple whose telephone number is 571.272.5588. The examiner can normally be reached on Monday - Friday 9:00-5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Trammell can be reached on 571-272-6712. The fax phone number for the organization where this application or proceeding is assigned is 571-272-6126.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

ksa

/Mary Cheung/

Primary Examiner, Art Unit 3694

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(10) Response to Argument

Argument for Independent Claim 1, 7, 11, 16, 17, 20 & 21

Appellant argues 1a first sub issue was whether the Office Action provided... evidence burden of proof standard.

This argument is moot since there was not specific explanation of what "evidence" was missing.

Appellant argues 1b second sub issue was whether the Office Action provided... prima face case of obviousness. This argument continue from page 17-20 discussing the feature of the appellant invention and the prior art. From page 17-19 the appellant explains their claims invention and then which of the two sited prior art reference the Office Action stated read upon the limitation. The final argument comes on page 19 explaining "so the issue becomes... to be combined" and on page 20 "namely is it not more probably... further modify" or page 21 “provide motivation”.

The examiner refutes these arguments and draws the attention to KSR. Appellants’ argues that there is not teaching suggestion or motivation to combine references. KSR forecloses Appellant’s argument that a specific teaching is required for a finding of obviousness. KSR, 127 S.Ct. at 1741, 82 USPQ2d at 1396. Claims 1, 19 & 27 recite combinations which only unite old elements with no change in their respective functions and which yield predictable results. Thus, the claimed subject matter likely would have been obvious under KSR. Quinlin and Solomon are analogous art and could be combined.

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(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner’s answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

/Kirsten S Apple/

Kirsten Sachwitz Apple
Primary Examiner
Art Unit 3693

Conferees:

James Trammell, SPE

/Mary Cheung/
Primary Examiner, Art Unit 3694

/James P Trammell/
Supervisory Patent Examiner, Art Unit 3694